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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,668	03/16/2004	Naoko Tsuji	250198US0DIV	3020

22850 7590 03/29/2005

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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EXAMINER

WITZ, JEAN C

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number. Applicants have identified this application as a division of Application No. 09/220,691, filed December 28, 1998. A divisional application is defined as a later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in an earlier or parent application. The divisional application should set forth the portion of the earlier disclosure that is germane to the invention as claimed in the divisional application. A review of the parent application provides no indication that a restriction requirement was made during the prosecution of the parent application. Therefore, it appears that the instant application is a continuation of the parent application. Appropriate correction is requested.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 6-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent 5,095,007 to Ahluwalia.

The reference discloses compounds effective to inhibit hair growth. Specifically identified are phosphonic acid compounds and derivatives thereof. See col. 1, lines 43-50. Absent objective evidence to the contrary, the characteristic of inhibition of the neutral endopeptidase is deemed an inherent characteristic of the disclosed compounds since they share the structural similarity claimed and have the same therapeutic activity of inhibition of hair growth. Once a reference teaching a product appearing to be substantially identical to the claimed invention and the Examiner presents evidence or reasoning tending to show inherency, the burden shifts to the Applicant to show that the claimed invention is novel over the cited prior art.

3. Claims 6 and 8-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent 5,962,466 to Styczynski et al.

The reference discloses compounds effective to inhibit hair growth. Specifically identified are phosphonic acid compounds and derivatives thereof. See claim 8. Absent objective evidence to the contrary, the characteristic of inhibition of the neutral endopeptidase is deemed an inherent characteristic of the disclosed compounds since

they share the structural similarity claimed and have the same therapeutic activity of inhibition of hair growth. Once a reference teaching a product appearing to be substantially identical to the claimed invention and the Examiner presents evidence or reasoning tending to show inherency, the burden shifts to the Applicant to show that the claimed invention is novel over the cited prior art.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

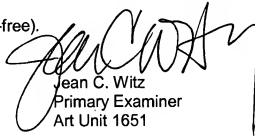
2. Claims 6-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,747,017. Although the conflicting claims are not identical, they are not patentably distinct from each other because the cited claims disclose the use of the same compounds for the same ultimate purpose. When the specification is consulted to determine the definition and scope of the term "neutral endopeptidase inhibitor", the term is deemed to encompass the same phosphonic acid compounds and derivatives

and salts thereof as those claimed phosphonic acid compounds, derivatives and salts thereof. Therefore, the cited claims inherently performs the claimed method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean C. Witz whose telephone number is (571) 272-0927. The examiner can normally be reached on 6:30 a.m. to 4:00 p.m. M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jean C. Witz
Primary Examiner
Art Unit 1651